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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,267	05/01/2001	Timothy Merrick Long	169.2039	3091
5514 7590 10/03/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/845,267

Applicant(s)

LONG, TIMOTHY MERRICK

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25,29-31 and 37-41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 25,29-31 and 37-41 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 July 2006 has been entered.

### *Resumption after Suspension*

2. The suspension of prosecution requested by applicant under 37 CFR 1.103(a) with the RCE filing on 23 October 2006 began with the mailing of the notice of approval on 17 January 2007. The maximum initial period of six months having expired without further request from applicant, prosecution is being continued. See MPEP § 709.

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 33351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (US005933811A). Angles et al. teaches an information appliance, comprising:

a display (col. 11 line 64) having a working display area incorporating an ad display area (*advertisement insert 56*, col. 12 lines 51-58 and Fig. 4) disposed within a working display area (*electronic page 32*), said ad display area being adapted to display advertising information independently of a plurality of different non-advertising applications (an Internet access application, col. 1 lines 45-50 and col. 10 lines 46-50, and an application to activate hyperlinks, col. 2 lines 4-11 and col. 7 lines 27-33) being run on the information appliance (within the non-advertising area of *electronic page 32*), even when any of the plurality of non-advertising applications displays non-advertising information on the working display area (inherently, because, as has been stated, the two displays are independent); and

sending the consumer unique software to allow ads to be merged with content (col. 3 lines 25-28), which inherently reads on input means adapted to accept a software upgrade for a non-advertising application.

6. The following limitation does not add structure to the element it modifies, the input means, and was accordingly not given patentable weight. (Apparatus claims must be structurally distinguishable from the prior art, MPEP § 2114.)

“for a non-advertising application, said software upgrade being configured to update advertising information, wherein said updated advertising information is displayed, independently of the plurality of non-advertising applications being run on the information appliance, even when any of the plurality of non-advertising applications displays non-advertising information on the working display area.”

7. Claims 29-31 and 37-41 are rejected under 35 U.S.C. 103(a) as being obvious over Angles et al. in view of Krishan et al. (US006442529B1).
8. Angles et al. does not teach (independent claims 29 and 39) determining a price/price determination means adapted to determine said price dependent upon a difference between said advertising cost and said manufacturing cost. Krishan et al. teaches using advertising revenue to subsidize providing the users with the appliance (*mini-portal device*, col. 4 lines 3-5), which reads on determining a price/price determination means adapted to determine said price dependent upon a difference between said advertising cost and said manufacturing cost. Because Krishan et al. teaches that this would help smaller ISPs remain competitive (col. 1 line 66 to col. 2 line 12), it would have been obvious to one of

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ordinary skill in the art, at the time of the invention, to add the teachings of Krishan et al. to those of Angles et al.

9. Neither reference teaches (claim 29) appliance selling means and advertising selling means. An ordinary telephone reads on such means. Because it is a well known and useful sales tool, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a telephone/appliance selling means/advertising selling means to the teachings of Krishan et al. and Angles et al.
10. Neither reference explicitly teaches (independent claim 37) means for producing upgrade software. However, since the structure recited in the references is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the reference does teach upgrade software (para. 5 above), so there must inherently be means for producing upgrade software. Neither reference teaches upgrade price determination means, but the logic given in para. 8 above for the appliance also applies to upgrade software. It is common, and necessary, to have advertising cost determination means if one wants to sell advertising, so, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add advertising cost determination means to the teachings of Angles et al. and Krishan et al.
11. Neither reference teaches (claim 31) that advertising cost is dependent on time period of display. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed on 17 October 2005 (para. 17). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)
12. Neither reference teaches (claims 30 and 38) that said price includes a profit. Because a business can be viable only if it makes a profit, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Angles et al. and Krishan et al. that the price of said appliance/upgrade software includes a profit.
13. Neither reference teaches (claims 40 and 41) that the advertising information is pre-loaded before manufacture into the information appliance or loaded after manufacture using an insertable memory medium. Both of these approaches for loading software were well known at the time of the instant invention. Because it is obvious to use the familiar, it would

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have been obvious to one of ordinary skill in the art, at the time of the invention, to either pre-load advertising information before manufacture into the information appliance or load said information after manufacture using an insertable memory medium. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed on 17 October 2005 (para. 13 for claims 33 and 34). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

### ***Response to Arguments***

14. Applicant's arguments filed with an amendment on 26 July 2006 have been fully considered but they are not persuasive.
15. Applicant argues,

"The applied references are not seen to disclose or to suggest the features of independent Claim 25, and in particular, are not seen to disclose or to suggest at least the features of an advertising display area adapted to display advertising information independently of a plurality of different non-advertising applications being run on the information appliance, even when any of the plurality of non-advertising applications displays non-advertising information on a working display area." (Page 8, first para., emphasis added.)

The rejection (para. 5 above) has been revised to explicitly cite a plurality (two) different non-advertising applications.

### ***Further comment on Patentability***

16. Applicant could claim the combination of software upgrade and advertisement update in such a way as to be a structural limitation to claim 25, but it would not be helpful to patentability. Such a combination is taught by Reilly et al. (col. 8 lines 24-29) and, as also suggested by Reilly et al., it would be obvious to do both together for the sake of convenience.

**Conclusion**

17. This is a continuation of applicant's earlier Application No. 09845267. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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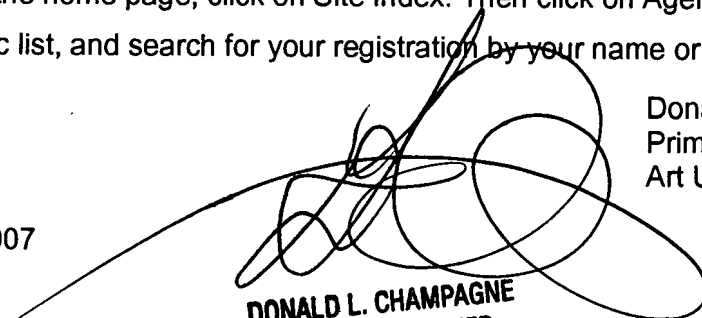
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

23. Applicant may have after final arguments considered and amendments entered by filing an RCE.

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

19 September 2007



**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Donald L. Champagne  
Primary Examiner  
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